



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/262,870	03/04/1999	MICHAEL D. ELLIS	UV-48	1124

7590 09/10/2007  
MICHAEL E SHANAHAN  
FISH & NEAVE  
1251 AVENUE OF THE AMERICAS  
NEW YORK, NY 100201104

EXAMINER
----------

LONSBERRY, HUNTER B

ART UNIT	PAPER NUMBER
----------	--------------

2623

MAIL DATE	DELIVERY MODE
-----------	---------------

09/10/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/262,870	<b>Applicant(s)</b> ELLIS, MICHAEL D.	
	<b>Examiner</b> Hunter B. Lonsberry	<b>Art Unit</b> 2623	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 May 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13,15,16,18,50-59,62-66,98-107,110-114 and 146-157 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13,15,16,18,50-59,62-66,98-107,110-114 and 146-157 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Applicant's failure to properly traverse the Official Notice(s) taken in the previous action is viewed as admission of prior art.

### ***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-11, 14-15, 17, 50-59, 65, 98-107, 110, 113, and 146-157 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,732,369 to Schein et al.

Regarding claim 1, 50, 98, and 146-148, and 98, Schein discloses an EPG system implemented on viewer television equipment (column 6, lines 59-66) having a main display screen comprising

Means for displaying a given television program (column 5, lines 61-65) for displaying images (TV 32)

Means for displaying a partial screen guide display on the viewer television equipment at the same time that said given television program is displayed (TV 32, figures 16-18), said program guide display including at least one VOD listing (fig 18b-d, column 23, lines 43-65) further a viewer may watch a main program in the background while browsing through other menus, column 23, lines 39-42)

Means for allowing a viewer to select at least one of the video on demand program listings (column 23, lines 43-65, selection is done via a remote control column 22, lines 1-11).

Regarding claims 2 and 99, Schein shows in Figure 17, an EPG that is overlaid over a TV program (column 23, lines 39-42).

Regarding claims 3 and 100, Schein shows in Figure 17, in which a TV program has been reduced to show an unobscured view of the EPG.

Regarding claims 4 and 101, Schein discloses that a remote control may be used to interact with the EPG (column 22, lines 1-7).

Regarding claims 5 and 53, Schein discloses that VOD listings may be organized by category (figure 18b movies: drama, column 11, lines 40-column 12, line 26).

Regarding claims 6 and 102, Schein discloses that a subscriber may press a button on the remote to activate the EPG (column 23, lines 26-29).

Regarding claims 7 and 103, Schein discloses that a user may operate the remote to deactivate the EPG (column 23, lines 27-33)

Regarding claim 8 and 104, Schein Discloses in Figure 18b,e, that a user may press a button on the remote to retrieve more information on a VOD listing.

Regarding claims 9 and 105, Figure 18b,e, that a user may press a button on the remote to retrieve more information on a VOD listing.

Regarding claims 10 and 106, Schein discloses in Figure 18b,e, that a user may press a button on the remote to retrieve more information on a VOD listing

Regarding claims 11 and 107, Schein discloses that user may select and active items within the grid via a remote control (column 22, lines 1-11)

Regarding claim 15 and 113, Schein discloses in figures 18a-e that program are available on demand.

Regarding claim 51, Schein discloses in figure 17-18 overlaying an EPG over a TV display.

Regarding claim 52, Schein discloses in figure 16a that the program may be displayed unobscured and reduced in size.

Regarding claims 54 and 55, Schein discloses in Figure 4, that the EPG may be opened and closed via a remote control (column 23, lines 27-33).

Regarding claim 56, Schein discloses that a user may navigate listings in order to display a screen with more detailed information regarding the event (Figure 18b,e, a user may press a button on the remote to retrieve more information on a VOD listing)

Regarding claims 57 and 58, Schein discloses that a user may navigate listings in order to display a screen with more detailed information regarding the event on the main display screen (figure 18a-e), a user may purchase the event (column 23, line 52-65).

Regarding claim 59, Schein discloses that user may select and active items within the grid via a remote control (column 22, lines 1-11)

Regarding claim 65, Schein discloses in figure 18a-e that programs are VOD programs.

Regarding claims 149-157, Schein discloses in figures 18c/d/e a password and confirmation screen, which must be completed prior to completing the order, a completion screen is displayed after the order is completed.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 12-13, 18, 62-64, 110-112 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,732,369 to Schein et al.

Regarding claims 12-13, 63-64, and 111-112 Schein discloses in figure 18a, that a VOD program may be recorded. Schein however, fails to disclose where the program is recorded too and playing back the recorded program.

The Examiner takes official notice that recording a VOD program to a VCR and using the VCR to play back the program is notoriously well known in the art. VCR's provide a convenient way to store programming and allowing a user to watch it at a later time of their choosing.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify Schein to utilize a VCR to record VOD programming, to

provide a convenient way to store programming and allowing a user to watch it at a later time of their choosing.

Regarding claims 18, 62 and 110, Schein discloses that users may navigate an EPG and use a password to order items in figure 18.

Schein fails to disclose utilizing a parental control code.

The examiner takes official notice that entering a parental control code is notoriously well known in the art, for example the use of a code to unlock a blocked television channel. Parental control codes prohibit viewers from viewing age inappropriate content.

Therefore it would have been obvious to one skilled in the art at the time of invention to modify Schein to include a parental control code for the advantage of prohibiting viewers from viewing age inappropriate content.

3. Claims 66 and 114 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 6,732,369 to Schein in view of U.S. Patent 6330,586 to Yates.

Regarding claim 66, Schein discloses in figure 16a icons for channels. 25

Schein does not disclose the use of an icon to indicate a VOD even



Yates discloses the use of a VOD Icon to identify a VOD application (column 26, lines 61-67), thus enabling a user to easily identify types of programming and aiding the viewing experience.

Therefore, it would have been obvious to one skilled in the art at the time of invention to modify Schein to include an icon to identify VOD programming as taught by Yates in a browser for the advantage of allowing a subscriber to easily identify programs to watch and aiding the viewing experience.


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hunter B. Lonsberry whose telephone number is 571-272-7298. The examiner can normally be reached on Monday-Friday during normal business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2623

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Hunter B. Lonsberry  
Primary Examiner  
Art Unit 2623

HBL